



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,173	10/31/2003	Vivek Jain	JP920030155US1	1599
7590 Frederick W. Gibb, III McGinn & Gibb, PLLC Suite 304 2568-A Riva Road Annapolis, MD 21401				
12/12/2008				
EXAMINER				
AHMED, AFFAF				
ART UNIT		PAPER NUMBER		
3622				
MAIL DATE		DELIVERY MODE		
12/12/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/699,173

**Applicant(s)**

JAIN ET AL.

**Examiner**

AFAF AHMED

**Art Unit**

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 43-84 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 43-84 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17 (e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17 (e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/07/2008 has been entered.
2. Claims 43, 58, 68, 69 and 84 have been amended.
3. Claims 43-84 are currently pending and have been examined.

### ***Response to Applicant's Arguments***

4. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.
5. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

### ***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:  

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
7. Claims 43-67 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).
3. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being

transformed, for example by identifying the material that is being changed to a different state. Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be preformed without the use of a particular apparatus. Thus, claims 43-67 are non-statutory since they may be preformed within the human mind.

### ***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:
- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
9. Claims 44-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
10. Claims 44-51 recites *wherein said shopper-group interaction measure is determined based on any of a shopper affinity index, leadership index, conformity index and an assertiveness index*. It is unclear what Applicant is referring to by *shopper-group interaction measure based on any of a shopper affinity index, leadership index, conformity index and an assertiveness index*. the shopper-group measure is already determined by previous interaction as shown in claim 43. Appropriate correction and/or clarification is required.

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 43, 44, 56, 58, 62, 68, 69, 70, 78, 82 and 84 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Sundareasan US Pat No: 7,219,072 B1 in view of Moffett, Jr. US Pub No: 2002/0103746 A1.

**Claims 43, 58, 68, 69, 78 and 84:**

Sundareasan discloses:

- *a computerized shopping system (see at least column 1, lines 46-67 and column 3, lines 34-51);*
- *collecting data regarding choices of individual shoppers when shopping individually;*
- *collecting group shopping data regarding the choices of individual shoppers when participating in group shopping, sending said targeted information to one or more targeted shoppers;*

See at least column 2, lines 1-27, column 3, lines 18-27;

- *determining an individual shopping behavior measure from the individual shopper data ;*
- *determining a group shopping behavior measure from the group shopping data;*

See at least column 2, lines (16-27 and 55-64) and column 5, lines 1-8;

- *determining targeted information on a basis of said shopper-group interaction measure;*

See at least column 2, lines 55-67, column 3, lines 18-30 and column 5, lines 18-51;

*determining a shopper-group interaction measure from individual shopper data and group shopper data, said group shopper data comprising a record of previous interaction between individuals within a shopping group of individual performing said group interaction (see at least column 2, lines 1-27, column 5, lines 1-51);*

Sundaresan does not specifically disclose, but Moffett however discloses:

- *said group shopping comprising multiple individuals making at least one group purchase (see at least the abstract and paragraphs 19 and 43) ;*
- *a shopper paying for the shopper's individual share of the shopping group's purchase (see at least the abstract and paragraphs 7 and 17);*

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Sundaresan's method and system for co-browsing in electronic ecommerce with Moffett's system and method of customizable group purchase with the motivation of empowering a buyer's online shopping experience while maximizing the benefits of purchase as a group to the group members.

**Claims 44, 49, 56, 62, 70 and 82:**

Sundersan/ Moffett disclose the limitations as shown above.

Sundersan does not specifically disclose:

- *wherein said shopper-group interaction measure is determined based on leadership index that is determined from records of shopper recommendations of said number of times other shoppers have followed such a recommendation;*

However, Sundaersan in at least column 3, lines 10-17 discloses a method that facilitates in bringing the user's shopping experience closer to traditional shopping experience. the method provides user with ability to chat with other shoppers browsing similar items in a conventional e-store and the ability to exchange suggestions and recommendations regarding the available selection of products. Sundersan also in at least column 4, lines 52-67 discloses a chatting window comprises at least two panes that provide the user with the ability to engage in the shopping/ browsing experience while chatting with one or more additional shoppers to directly relate to and influence the user's shopping experience. Furthermore, Sundersan in at least column 5, lines 1-27 discloses a server that can access stored information regarding previous visits and purchases made by the shopper including past co-browsing behavior.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Sundersan's method and system of shoppers chatting (making recommendation) with other users of similar characteristics and/or interest with a record of times other shopper shopper's have followed such a recommendation with the motivation of allowing advertisers to quickly identify certain group interest and/ or product.

14. Claims 45-48, 50-51, 70-74 and 76-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sundareasan US Pat No: 7,219,072 B1 in view of Moffett, Jr. US Pub No: 2002/0103746 A1 in view of Bieganski et al US Pat No: 6,334,127B1.

**Claims 45-48, 50-51, 70-74 and 76-77:**

Sundareasan/Moffett disclose the limitations as shown above.

Sundareasan does not specifically disclose:

- *wherein said shopper affinity index is determined from a number of times a shopper has voted with other members of a group of shoppers.*
- *wherein said shopper affinity index is determined from a number of times a shopper's proposal has been voted for by other members of a group of shoppers.*

- *wherein said shopper affinity index is determined from a number of times a shopper has been invited by, or issued an invitation to other members of a group of shoppers.*
- *wherein said shopper affinity index is determined from a number of shopping groups that a shopper is a commonly member of with other shoppers.*
- *wherein said conformity index is determined from a voting record of said shopper regarding purchase proposals with reference to agreeing with a majority or lead shopper's vote within a group of shoppers.*
- *wherein said assertiveness index is determined from a voting record of said shopper regarding purchase proposal with reference to disagreeing with a majority of lead shopper's vote within a group of shoppers.*

However, Examiner notes applicant states that shopper-group interaction measure is determined based on any of a shopper affinity index, a leadership index, a conformity index, and an assertiveness index. It has been held that Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP §2106 II C). Furthermore, for the prosecution of this application Bieganski in at least column 6, lines 37-55 discloses that there are many different methods to form affinity groups. Therefore, it would have been obvious to one of ordinary skill in the art to modify Sundareasan's/ Moffett system and method of co-browsing and group shopping in with different methods to form affinity groups with the motivation of quickly referring to the right affinity group that offer more empowered online shopping experience for the buyer.

15. Claims 52-55, 57, 59-63, 64-67, 79-81 and 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sundersan US Pat No: 7,219,072 B1 in view of Moffett, Jr. US Pub No: 2002/0103746 A1 in view of Eldering US Pat No: 6,298,348.

**Claims 52-55, 57, 59-63, 67, 79-81 and 83:**

Sundareasan/ Moffett disclose the limitations as shown above.

Sundareasan does not specifically disclose, however, Eldering discloses:

- *wherein a shopper parameter specified by said merchant's rule to target information to a group or to individual shoppers for a particular promotion of goods or services (see at least see at least column 2, lines 32-47 and column 6, lines 55-59 and 3A with the associated text).*

It would have been obvious to one of ordinary skill in the art to combine Sundareasan's / Moffett system and method of co-browsing and group shopping in electronic commerce

with Eldering's online consumer profiling system with the motivation of targeting consumers and presenting them with effective advertisement to help them making informed decisions about which products and/ or services to purchase.

**Claims 64 and 66:**

Sundareasan / Moffett disclose the limitations as shown above.

The combination of Sundareasan/ Moffett does not specifically disclose, however, Eldering discloses:

- wherein said group shopping measure is determined by a group of youthfulness;
- wherein individual shopping behavior measure comprises information on demographics, income, purchase history, and preferences (see at least column 2, lines 32-47 and column 6, lines 55-59 and 3A with the associated text);

It would have been obvious to one of ordinary skill in the art to combine Sundareasan's/ Moffett system and method of co-browsing group shopping in electronic commerce with Eldering's online consumer profiling system with the motivation of determining the applicability of advertisements to consumers.

**Claim 65:**

Sundareasan / Moffett disclose the limitations as shown above.

The combination of Sundareasan/ Moffett does not specifically disclose:

- *wherein said group compatibility and agreement index is calculated based on a time series of group shopping history and said individual shopping behavior measure to give an indication of either assimilation leading to targeting information to a group, or lack of assimilation leading to targeting information to individual shoppers;*

However, Examiner note that applicant states that *wherein said group shopping measure is determined by any of: a group compatibility and agreement index, a maturity index, a group youthfulness index, and a group harmony index*. It has been held that Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP §2106 II C).



***Conclusion***

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Affaf Ahmed whose telephone number is 571-270-1835. The examiner can normally be reached on Monday - Friday, 8:30 am-6:00 pm est, alt Fridays off.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached at 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.  
AA

/Yehdega Retta/  
Primary Examiner, Art Unit 3622